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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/622,320	07/17/2003	Guy W. Bemis	VPI96-16CON	4334

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EXAMINER

RAO, DEEPAK R

ART UNIT

PAPER NUMBER

1624

DATE MAILED: 02/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/622,320

Applicant(s)

BEMIS ET AL.

Examiner

Deepak Rao

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 July 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 3, 8-15, 18-23 and 25-37 are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 3, 8-15, 18-23, 25-37 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claims 3, 8-15, 18-23 and 25-37 are pending in this application.

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 3, 8-12, 14-15, 18-23 and 25-37, drawn to (pyridine) compounds of formula (Ie) or (Ig) wherein each Y is C; A is C; n is 1; and two adjacent R together DO NOT form a ring, corresponding composition and method of use, classified in class 546, subclass various.
- II. Claims 3, 8-15, 18-21 and 25-37, drawn to (pyridazines) compounds of formula (Ie) wherein each Y is C; A is N; n is 1; and two adjacent R together DO NOT form a ring, corresponding composition and method of use, classified in class 544, subclass 224+.
- III. Claims 3, 8-13, 18-21 and 25-37, drawn to (tetrazine) compounds of formula (Ie) wherein each Y is N; A is N; n is 1, corresponding composition and method of use, classified in class 544, subclass 179.
- IV. Claims 3, 8-12, 18-21 and 25-37, drawn to (triazine) compounds of formula (Ie) or (If) wherein each Y is N; A is C; n is 1, corresponding composition and method of use, classified in class 544, subclass 180+.
- V. Claims 3, 8-12, 18-21 and 25-37, drawn to (pyrimidine or pyrazine) compounds of formula (Ie) or (If) wherein one Y is N; one Y is C; A is C; n is 1,

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corresponding composition and method of use, classified in class 544, subclass 234+.

- VI. Claims 3, 8-12, 14-15, 18-21 and 25-37, drawn to (pyrrole) compounds of formula (Ie) wherein each Y is C; n is 0; and two adjacent R together DO NOT form a ring, corresponding composition and method of use, classified in class 548, subclass 400+.
- VII. Claims 3, 8-12, 18-21 and 25-37, drawn to (diazole) compounds of formula (Ie) wherein one Y is N; one Y is C; n is 0; and two adjacent R together DO NOT form a ring, corresponding composition and method of use, classified in class 548, subclass 300.1+.
- VIII. Claims 3, 8-12, 18-21 and 25-37, drawn to (triazole) compounds of formula (Ie) wherein each Y is N; n is 0; and two adjacent R together DO NOT form a ring, corresponding composition and method of use, classified in class 548, subclass 262.2+.
- IX. Claims 3, 8-12, 18-21 and 25-37, drawn to compounds of formula (Ie) or (If) other than those of Groups I-VIII above, corresponding composition and method of use, classified in class 544/546/548, subclass various.

The inventions are distinct, each from the other because of the following reasons:

The compounds of Groups I-IX are drawn to structurally dissimilar compounds. They are made independently and used independently. They would be expected to raise different issues of patentability if a compound of Group I was anticipated, the anticipatory reference would not necessarily render obvious a compound of groups II-IX or vice-versa. They are not

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art-recognized equivalents, they are separately classified and require separate burdensome searches both in the literature and computer databases.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

Claims 3, 8-15 and 18-23 are generic to a plurality of disclosed patentably distinct species comprising the species disclosed in the specification, examples. In addition to the election of a single group from above, applicant is required under 35 U.S.C. 121 to **elect a single disclosed species falling within the elected group**, even though this requirement is traversed.

The compounds are structurally dissimilar such that a reference anticipating a compound may not render the remaining compounds obvious. 37 CFR 1.141(a) provides that two or more independent and distinct inventions may not be claimed in one application, whether or not the misjoinder occurred in one claim or more than one claim. Restriction is going to be exercised where independent and distinct inventions are presented in one Markush grouping. Independent means when the compound is being made and/or used alone, not in combination with other compounds of the Markush expression. Restriction is considered proper in Markush claims where the members are so diverse and unrelated that a prior art reference anticipating the claim with respect to one of the members, would not render the claims obvious under 35 U.S.C. 103 with respect to the other members. Therefore, what should be considered for patentable distinctness is the compound as a whole. Each of the species based on the various substituents are independently classified into different class/subclasses, thereby requiring consideration of

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thousands of patent documents. Further, these compounds require separate searches in the literature and therefore, involve burdensome search.

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

This restriction is being set forth in writing due to its lengthy nature and to facilitate applicant with sufficient information, to make an informed and correct election of the invention applicants would wish to have prosecuted in the application.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

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Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Deepak Rao whose telephone number is (571) 272-0672. The examiner can normally be reached on Tuesday-Friday from 6:30am to 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dr. Mukund Shah, can be reached on (571) 262-0674. If you are unable to reach Dr. Shah within a 24 hour period, please contact James O. Wilson, Acting-SPE of 1624 at (571) 272-0661. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-1600.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Deepak Rao
Primary Examiner
Art Unit 1624

February 23, 2005